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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,007	10/31/2003	Kazuki Emori	SHO-0030	8246

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EXAMINER	
SAVIC, BORIS	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,007	EMORI ET AL.	
	Examiner	Art Unit	
	Boris Savic	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/22/2004 and 6/18/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In *re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10697054. Although the conflicting claims are not identical, they are not patentably distinct from each other because both of them talk about game result display means for displaying a game result thereon; and beneficial state generating means for generating a beneficial state for a player; and wherein the game result display means includes first display means and second display means arranged at a more front side than a display area of the first display means when seen from a front side of the gaming machine.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Title Objections

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Masaaki Ozaki et al. (US 2001/0031658 A1).

Regarding claims 1 and 6, Ozaki teaches three transparent EL panels 28a, 28b, and 28c constitute a front side display means (display unit). Although several transparent EL panels are used in this embodiment, it is also possible to use a single transparent EL panel that is divided into several sections. (See page 2, paragraph 44) The pattern display unit has a plurality of first display portions each of which displays a corresponding one of the plurality of first patterns; the front side display unit has a plurality of second display portions corresponding to the plurality of first display portions and performing overlapping displays of the plurality of second patterns and the plurality of first patterns. (See Claim 10) The one of the relative position and the relative relations is determined to allow the plurality of first patterns to be seen completely

through the plurality of second display portions. (See Claim 11) A back side display unit for displaying a back pattern; a transparent front side display unit disposed in front of the back side display unit, for displaying a front pattern, wherein: the front pattern is displayed alone or together with the back pattern to be recognized as a game target display by a player; and a game condition is determined by the game target display. (See Claim 15)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masaaki Ozaki et al. in view of Timothy C. Loose (US 2003/0130033 A1).

Ozaki teaches the pattern display unit has a plurality of first display portions each of which displays a corresponding one of the plurality of first patterns; the front side display unit has a plurality of second display portions corresponding to the plurality of first display portions and performing overlapping displays of the plurality of second patterns and the plurality of first patterns. (See Claim 10) If the winning combination is not displayed by the back patterns 31 despite the fact that it is selected as a winning combination by the lottery, the CPU 51 makes the transparent EL panels 28a, 28b, and 28c display the overlapping patterns 32 to display the winning combination in coordination with the back patterns 31 and the overlapping patterns 32 (S107). (See

page 5, paragraph 74) If a winning condition is determined by the lottery and the corresponding winning combination is displayed by the back patterns 31 (S106: win), the CPU 51 makes the transparent EL panels 28a, 28b and 28c perform a stationary display of a set of overlapping patterns 32 that does not affect the stationary display of the back patterns 31 provided by already stopped reels 30a, 30b and 30c (S108). (See pages 5-6, paragraph 80) The game machine of claim 15, wherein: the player recognizes by the game target display whether the game condition is a winning condition; and the game machine has a means that notices the player that one of the winning condition and a loosing condition is established. (See Claim 18) The game machine of claim 18, wherein: the winning condition is established only when a combination of the back pattern and the front pattern displayed by the back side display unit and the front side display unit satisfies a front/back combination-permitting condition that is present. (See Claim 19) The game machine of claim 18, further comprising: a start signal output means for outputting a start signal; a lottery means for performing a lottery upon receiving the start signal to set the winning condition; a back side display control means for making the back side display unit perform a stationary display of the back pattern after performing a varying display, upon receiving the start signal; a front side display control means for controlling a display of the front side display unit, and making the front side display unit display the front pattern; and a means for giving a game value or an awarded item to the player when the winning condition is established. (See Claim 20) Ozaki does not teach the specific image being displayed based on a certain winning combination. Loose teaches one or more of the basic game outcomes

may trigger a bonus feature. The bonus feature may be played on the video display 12 or a secondary mechanical or video bonus indicator distinct from the video display 12. If the bonus feature is played on the video display 12, the bonus feature may utilize the display images of the basic game (e.g., slot reels in a slot game) or may replace the basic game images with bonus-specific images. Also, the bonus feature may depict one or more animated events and award bonus amounts based on an outcome of the animated events. (See page 1, paragraph 11) Therefore, it would have been obvious to one in ordinary skill in the art at the time of the invention to apply the specific image to the determined winning combination because it would be more interesting for a person who plays a gaming machine (slot machine) to get a specific image or picture of some kind with the winning combination or award that he/she received.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masaaki Ozaki et al. in view of Timothy C. Loose and further in view of Paulina Glavich et al. (US 2003/0064796 A1).

Regarding claim 4, Glavich teaches each terminating condition that is associated with a probability of occurring in a game such that the probability of one terminating condition occurring in a game is higher than another terminating condition occurring in a game. The probability of the terminating condition occurring may be higher than, equal to, or less than the probabilities of being indicated associated with an award symbol, a plurality of award symbols or all of the award symbols on the reels. Furthermore in another embodiment, the occurrence probability or probability of occurring associated with a terminating condition increases after each activation of a reel or reels. The

probability of occurring also may increase after a termination condition occurs in a game or after a plurality of terminating conditions occur in a game. It should be appreciated that the probability of occurring associated with a terminating condition may be the same for each reel, different for each reel or different for a plurality of reels. (See page 4, paragraph 47) Therefore, it would have been obvious to one in ordinary skill in the art at the time of the invention to apply a probability of determining a specific winning combination to Ozaki gaming machine because it would make the gaming machine much more interesting, trickier, and more entertaining.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Savic whose telephone number is (571) 272-2849. The examiner can normally be reached on Monday - Friday, 6:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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TC3700